

## **REMARKS**

Reconsideration of the Office action issued on March 17, 2004 is requested in view of the foregoing amendment and the following remarks. Prior to entry of the above amendment, claims 1-70 were pending and stand rejected under 35 U.S.C. § 112, first paragraph, and under the doctrine of obviousness-type double patenting. The specification was also objected to for missing the patent number of a priority application from which the present application continues therefrom and for failing to provide proper antecedent basis for the subject matter recited in the claims. By this response, the specification is amended to provide the missing patent number, a terminal disclaimer is submitted, and reconsideration of the remaining issues is requested.

The primary issue in the Office action is whether or not the present application discloses a hydrogen-selective membrane formed from an alloy containing palladium and silver. The express text of the present specification discusses that the membranes may be formed from palladium and/or a palladium alloy, such as an alloy of palladium and a metal. The specification continues to utilize as an example membranes with an alloy containing palladium and copper. The Examiner is correct that the express text of the specification does not recite an alloy containing palladium and silver. However, the specification clearly discloses on page 16, lines 18-21, that the recited low impurity membrane, and devices including the same, may include membranes having the primary compositions

disclosed in Applicants' U.S. Patent Nos. 6,221,117 and 6,319,306, the disclosures of which were incorporated by reference in the present application. U.S. Patent No. 6,221,117 specifically discloses that alloys containing palladium and silver may be used for hydrogen-selective metal membranes. For example, column 5, lines 50-52, specifically references alloys containing palladium and silver. If necessary, other examples can be provided from the various priority and other applications whose complete disclosures have been incorporated by reference into the present application. However, Applicants submit that the present example is sufficient to overcome the objection to the specification.

Claims 1-70 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement, and more particularly for claiming, amongst other subject matter, a hydrogen-selective membrane that is at least substantially comprised of a primary component that includes palladium and silver. In view of the above discussion regarding the incorporated scope of the present specification, Applicants request that the rejection of claims 1-70 under 35 U.S.C. § 112, first paragraph, be withdrawn.


Claims 1-70 also stand rejected under the judicially created doctrine of obviousness-type double patenting in view of Applicants' U.S. Patent No. 6,537,352. In the Office action, the Examiner suggests that the "silver" recited in the pending claims may have been intended to be "silicone." In view of the above, Applicants believe this is no longer in question. However, Applicants still

understand the basis of, and public policy behind, obviousness-type double patenting rejections and are submitting the requested terminal disclaimer to obviate the obviousness-type double patenting rejection.

With the entry of the above amendment and the enclosed Terminal Disclaimer, and for the reasons stated, Applicants submit that the presently pending claims are in a condition for formal allowance. If there are any remaining issues, or if the Examiner has any questions that may be resolved with a telephone interview, the Examiner is invited to contact Applicants' undersigned attorney at the number listed below.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'David S. D'Ascenzo', is written over a horizontal line.

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